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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,351	01/12/2005	Takamasa Katoh	H6808.0071/P071	9170
24998	7590	09/20/2007		
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER MARTINELL, JAMES	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/521,351

**Applicant(s)**

KATOH ET AL.

**Examiner**

James Martinell

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/21/07 & 7/2/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/2/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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Newly submitted claims 7-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the methods of claims 5 and 6 may be practiced by hand or on paper and do not require the apparatuses or computer programs of claims 7-12.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague, indefinite, and incomplete.

- (a) The recitation of "nucleotide sequence-related information associated with positional information" (claims 5 and 6) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 3, item (a)). Applicants assert (response filed June 21, 2007, page 10) that there should not be a problem with the term without offering a definition or explanation of the use of the term other than a vague assertion as to the "ordinary meaning" of the term. This is not an invitation to submit affidavit, documentary, or other evidence subsequent to a final Office action.
- (b) The recitation of "information corresponding to the positional information" (claims 5 and 6) is vague and indefinite because the instant application does not clearly define the term. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 3, item (b)).
- (c) The recitation of "semantic information" (claims 5 and 5) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed

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March 21, 2007, page 3, item (c)). Applicants' assertion (response filed June 21, 2007, page 9, first full paragraph) is not convincing.

- (d) The recitation of "information implied" (claims 5 and 6) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 3, item (d)). Applicants' assertion (response filed June 21, 2007, page 9, first full paragraph) is not convincing.
- (e) The recitation of "information associated with the semantic information" (claims 5 and 6) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 4, item (e)). Applicants' assertion (response filed June 21, 2007, page 10, third full paragraph) is not convincing. Applicants assert that there should not be a problem with the term without offering a definition or explanation of the use of the term other than a vague assertion the "phrase is a common element of the English language." This is not an invitation to submit affidavit, documentary, or other evidence subsequent to a final Office action.
- (f) The recitation of "associated with positional information representing a position in a nucleotide sequence" (claims 5 and 6) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 4, item (i)). Applicants' assertion (response filed June 21, 2007, page 10, third full paragraph) is not convincing. Applicants assert that there should not be a problem with the term without offering a definition or explanation of the use of the term other than a vague assertion the "phrase is a common element of the English language." This is not an invitation to submit affidavit, documentary, or other evidence subsequent to a final Office action.
- (g) The recitation of "obtaining from among a plurality . . . corresponding to the positional information received in step (a)" is vague and indefinite. This rejection is

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repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 5, item (o)). Applicants' assertion (response filed June 21, 2007, page 9, fourth full paragraph) is not convincing because applicants' "explanation" is no clearer than the language of the claim it is intended to explain.

- (h) The recitation of "consistency" (claims 5 and 6) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 5, item (p)). Applicants' argument (response filed June 21, 2007, page 10, first full paragraph) is not convincing. Applicants argue that they have used "an ordinary, English-language, word consistent with its dictionary-definition meaning." This argument is devoid of meaning in the absence of any dictionary definition in this record. Moreover, applicants then go on to assert that the word should be taken to have meaning according to the examples following page 17, line 8 of the application. Applicants have thus, asserted more than one meaning for the term in their argument. The term remains vague and indefinite. This is not an invitation to submit affidavit, documentary, or other evidence subsequent to a final Office action.
- (i) The recitation of "positional information associated with the nucleotide sequence-related information transmitted in step (c)" (claims 5 and 6) is vague and indefinite. This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, page 5, item (s)). Applicants' assertion (response filed June 21, 2007, page 10, third full paragraph) is not convincing. Applicants assert that there should not be a problem with the term without offering a definition or explanation of the use of the term other than a vague assertion the "phrase is a common element of the English language." This is not an invitation to submit affidavit, documentary, or other evidence subsequent to a final Office action.

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- (j) The recitation of "a third party" (claim 6) is incomplete because there is no antecedent basis for the phrase. Applicants' denial of the basis for the rejection (response filed June 21, 2007, second full paragraph) is not convincing in the absence of an explanation for the antecedent basis for the phrase.

Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any one of Boyce-Jacino et al (WO 01/26029 (April 12, 2001)), Denton et al (WO 01/01218 (January 4, 2001)), or Qiagen Product Guide 2000 (Qiagen Inc., Valencia, CA 2000, pages 250-253). This rejection is repeated for reasons already of record (*e.g.*, Office action mailed March 21, 2007, paragraph bridging pages 5-6. Applicants' arguments (response filed June 21, 2007, pages 10-11) are not convincing. Applicants argue that none of the references teaches the step of comparing data from steps (c) and (d). This argument is not persuasive because each of the references teaches comparison of data, which is thus embraced by the claims (*e.g.*, see the portions of the reference referred to in the Office action mailed March 21, 2007). In addition, applicants assert that none of the references teaches a step to alert a party of the results. This argument is not persuasive since the purpose of the methods described by the references is to compare nucleotide sequence data. The reporting of the results of the comparisons of data to a user or users (*i.e.*, a third party as in claim 6) is inherent in the methods of each of the references.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to [james.martinell@uspto.gov](mailto:james.martinell@uspto.gov). Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.


#### **OFFICIAL FAX NUMBER**

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
**James Martinell, Ph.D.**  
**Primary Examiner**  
**Art Unit 1634**  
9/16/07